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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WARD AND OLIVA
708 THIRD AVENUE
NEW YORK, NY 10017

EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/11/2001

13

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-13

Office Action Summary

Application No.
09/332,863

Applicant(s)
Imperial

Examiner
Brian Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Oct 9, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 25-97 is/are pending in the application

4a) Of the above, claim(s) 69-97 is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 25-68 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election of Group I, claims 25-68 in Paper No. 12 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 69-97 drawn to an invention nonelected with traverse in Paper No. 12. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Objections

3. Claims 28-31 and 35-40 are objected to because of the following informalities: In claims 28 and 29, the term "alkalai" should be changed to "alkali". Claims 30-31 are objected to for being dependent upon claim 38. In claim 35, the phrase "comprised of" should be changed to either "are comprised of" or "comprise" for grammatical purposes. Claims 36-40 are objected to for being dependent upon claim 35. Appropriate correction is required.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 33-40, 49 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The phrase “generally inert particulate” in claim 33 renders the claim indefinite. The phrase “generally inert particulate” renders the claim indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the term “generally”. The examiner notes that the instant specification does not define the phrase “generally inert particulate”.

Appropriate correction and/or clarification is required.

7. The Markush group “C₁₂ isoparaffins” in instant claim 49 renders the claim indefinite, since “C₁₂ isoparaffins” are not volatile silicones. The examiner suggests that claim 49 should be amended to delete the Markush group “C₁₂ isoparaffins”. Appropriate correction and/or clarification is required.

8. Claim 54 contains the trademarks/trade names “Beheneth 5-30”, “Cetareth 2-100” and “Ceteth 1-45”. Where a trademark or trade name is used in a claim as a limitation to identify or

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describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe products and, accordingly, the identification/description is indefinite.

9. Claims 34-40 and are rejected under 35 U.S.C. 112, second paragraph, for being dependent upon a claim with the above addressed 112 problem.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 25, 59 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Henkel, DE 2,624,690.

Henkel, DE 2,624,690, teaches a three part blonding mixture for hair, see provided CAPLUS Abstract. The first part comprises an aqueous solution of a mixture of dyes, one of which is a cationic dye as claimed (Brilliant Blue R 28032) in the claimed amounts, see Abstract and Example 1. The second part comprises a 6% aqueous solution of hydrogen peroxide, and the third part comprises solid (i.e. powdered) ammonium persulfate, see Abstract and Example 1. Therefore, instant claims 25, 59 and 60 are anticipated by Henkel, DE 2,624,690.

11. Claims 26-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henkel, DE 2,624,690.

Henkel, DE 2,624,690, is relied upon supra as disclosing a three part blonding mixture for hair comprising a cationic dye, an aqueous solution of hydrogen peroxide and a persulfate. It is further taught by Henkel that the solid persulfate-containing composition may also contain 1-8% by weight of fillers, including those which read on the claimed inorganic colorants, see page 5,

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paragraph 2. Henkel teaches the equivalence between ammonium and sodium and potassium persulfate as claimed, wherein the persulfate may be present in the solid composition in an amount between 2-45% by weight, see page 5, first paragraph. The persulfate, developer and colorant compositions are mixed in the claimed amounts, and are applied to hair for the claimed times followed by rinsing, see Abstract and Example 1. The examiner asserts that the persulfate compounds and filler compounds disclosed by Henkel would inherently meet the particle sizes claimed in instant claims 31 and 34, absent a showing otherwise. Although Henkel generally teaches the inclusion of alkali metal persulfates and fillers in the hair treatment composition, the reference does not require these components with sufficient specificity, as required by applicant in claims 26-42.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have formulated a hair treatment composition which contained all of the components in the claimed amounts disclosed and taught by Henkel, including alkali metal persulfates and fillers. Therefore, one of ordinary skill in the art would have had a reasonable expectation of success, because such a hair treatment composition containing these components is expressly suggested by the Henkel disclosure and therefore is an obvious formulation.

12. Claims 25-47, 50-53, and 55-68 are rejected under 35 U.S.C. 102(a) as being anticipated by Goldwell, DE 19721785.

Goldwell, DE 19721785, exemplifies a three part composition for simultaneously coloring and brightening hair, see compositions A1, B1 and C on pages 13-16. In the Example, 6

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grams of composition A1 is mixed with 6.25 grams of composition B1, 8.75 grams of composition C, and 20ml (20 grams) of water, see Example (a) on page 16. The final composition contains 0.64% by weight of azo and phenazine cationic dyes, 8.85% by weight inorganic persulfate (including potassium persulfate), 1.28% by weight hydrogen peroxide, and 2.92% by weight of the cationic surfactant/compound hydroxypropyl guar trimmonium chloride. Particularly, the first part, composition A1, is a colorant composition which comprises cationic dyes, a cationic surfactant, and a protein derivative (wheat protein hydrolyzate) as claimed in the claimed amounts, and humectants as claimed (PEG derivatives), see pages 13-14. The second part, composition B1, is powdered and comprises ammonium and potassium persulfate and particulate fillers (e.g. pyrogenic silica) in the claimed amounts, an inorganic colorant (magnesium oxide), and a paraffin oil, see pages 14-15. The magnesium peroxide may be present in the claimed inorganic colorant amounts, see page 11, lines 7-11. The third part, composition C, comprises hydrogen peroxide, water and an oily phase (cetyl stearyl alcohol) in the claimed amounts, see page 16. As explained above, the three compositions are mixed with 20ml of water, and is applied to the hair, followed by rinsing, see page 16. It is further taught by Goldwell that thickening agents, such as polyacrylic acid, are preferred in the composition, see page 5, lines 8-12, and that the composition may be applied as an emulsion, see page 13, lines 8-13. The examiner asserts that the persulfate compounds and filler compounds disclosed by Goldwell would inherently meet the particle sizes claimed in instant claims 31 and 34, absent a showing otherwise. Therefore, instant claims 25-47, 50-53, 55-68 are anticipated by Goldwell, DE 19721785.

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13. Claims 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwell, DE 19721785, as applied to claims 25-47, 50-53, 55-68 above, and further in view of Yoshihara, U.S. Patent No. 5,332,581.

The primary reference of Goldwell, DE 19721785, is relied upon above as teaching compositions and methods for coloring and highlighting the hair as claimed, wherein cationic direct dyes may be used as the colorants. The patentee does not appear to teach the addition of silicones to the colorant compositions as required by applicant in claims 48-49.

The secondary reference of Yoshihara, U.S. Patent No. 5,332,581, teaches keratinous fiber treating compositions which are preferably formulated as hair coloring compositions which contain direct dyes, wherein preferred direct dyes include cationic or basic direct dyes, see Abstract and col. 3, lines 12-19 and col. 4, lines 3-11. Yoshihara teaches that silicones are preferably added to the compositions in the claimed amounts in order to improve the texture of the hair, see col. 4, line 64-col. 5, line 19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a silicone in the claimed amounts to Goldwell's colorant compositions because Yoshihara teaches that the addition of such silicones in the claimed amounts to hair colorant compositions, including those which may contain basic dyes, results in improved hair texture.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

BPM

Brian Mruk
December 4, 2001

Lorna M. Douyon
LORNA M. DOUYON
PRIMARY EXAMINER